

REMARKS

Reconsideration and further examination of the application, as amended, are respectfully requested.

This Preliminary Amendment is being filed together with a Request for Continued Examination (RCE) in response to a final Office Action mailed November 20, 2003.

In the final Office Action, claims 1-3 and 6-8 were rejected under U.S.C. §103(a) as being obvious based on U.S. Patent No. 6,360,263 to Kurtzberg et al. ("Kurtzberg") in view of U.S. Patent No. 6,473,424 to DeJager ("DeJager"). Claims 4, 5, 9 and 10 were rejected as being obvious based on Kurtzberg, DeJager and in further view of U.S. Patent No. 6,173,346 to Wallach et al. ("Wallach"). Claims 13-16 were allowed and claims 11 and 12 were objected to.

Claims 1-12 have been canceled, claims 13-16 have been amended and new claims 17-41 have been added. Claims 13-16 have been amended to better claim embodiments of the invention. No new matter has been introduced. Support for new claims 17-41 may be found, for example, in the specification as originally filed at pp. 9-13 and in the prior versions of claims 13-16, among other places. Applicants submit that amended claims 13-16 and new claims 17-41 are in condition for allowance.

New, independent method claim 17, for example, recites, in relevant part:

"identifying the number of I/O devices being serviced by each port"

In rejecting now canceled claim 1, the prior Office Action cited to Col. 2, lines 51-55 of Kurtzberg as teaching or suggesting a similar step. See Office Action dated June 6, 2003 at ¶4. Applicants respectfully disagree.

Col. 2, lines 51-55 of Kurtzberg recite, in their entirety, as follows:

FIG. 3 shows the resource monitor: it specifies four resource types, namely, main memory, secondary memory, CPU loading, and **external connections**. These resource types are needed to satisfy the requirements of programs and data modules of any user. (emphasis added)

First of all, Kurtzberg is directed to a system for optimizing the allocation of resources of a multi-processor, time-shared computer system among a plurality of users, each of whom has a "job" to be executed by the computer. See Kurtzberg, Col. 1, lines 26-29. Accordingly, what Kurtzberg is teaching in the above quoted excerpt, i.e., at Col. 2, lines 51-55, is that his resource monitor considers four different types of resources of the shared computer system. Kurtzberg contends that it is these four types of computer resources, i.e., main memory, secondary memory, CPU loading and **external connections** that are needed to execute the user's jobs.

Kurtzberg makes no reference to devices, and thus provides no teaching or suggestion for identifying the number of **devices** being serviced by an I/O port of a computer. At best, Kurtzberg's resource monitor simply specifies the "external connections" of its computer system. Specifying a computer's external connections, e.g., the number of external connections, however, does not provide any indication as to the number of **devices** that might happen to be coupled to those external connections. For example,

some external connections may have multiple devices whereas others may not have any. Kurtzberg provides no teaching or suggestion for making this extra determination regarding the number of devices coupled to a given I/O port. Indeed, Kurtzberg nowhere even mentions the word “device” in its written description. Based on the foregoing, applicants respectfully submit that the amended and new claims are distinguishable over Kurtzberg and the art of record.

In addition, a device, such as Kurtzberg’s shared computer cannot be used to reject a method claim, such as new claim 17, unless it can be shown in the Office Action that the prior art device, in its normal and usual operation, would **necessarily** perform the claimed method. See MPEP §2112.02. Furthermore, where the prior art device and the Applicants’ preferred device, as described in the application, are not the same, then there can be no presumption that the prior art device performs the claimed process. Id. Here, the prior art device of Kurtzberg is a time-shared computer. In contrast, the preferred embodiment for the claimed method is an I/O bridge. Thus, a rejection of method claim 17 based on the device of Kurtzberg would be improper.

Applicants have also amended the specification to correct several minor errors. For example, when formal drawings were prepared for this application, original Figures 10A-C became 10A-E. Applicants have corrected the specification to account for this change. Applicants have also amended the title.

Applicants submit that the application, as amended, is in condition for allowance and early favorable action is requested.

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Respectfully submitted,



Michael R. Reinemann
Reg. No. 38,280
Tel. 617-951-3060

Please direct all correspondence to:
IP Administration Legal Department,
M/S 35
Hewlett-Packard Co.
P.O. Box 272400
Fort Collins, CO 80527-2400